

REMARKS

Claims 31-61 are pending. Claims 31, 36-38, 51, and 56 are currently amended.¹ Claim 58 is canceled. Accordingly, claims 31-57 and 59-61 will remain pending after entry of this paper.

No new matter is added by virtue of the within amendment; support therefore can be found at least at paragraph [0020] of the application as published.

As an initial matter, attention is drawn to the response filed on October 20, 2009. Subsequent to that submission, a telephonic interview was conducted with the Examiner and it was agreed that a Supplemental Amendment could be submitted for consideration prior to the Examiner's deadline to act on the response dated October 20, 2009. Accordingly, the within amendments and remarks are to be considered supplemental to the response filed on October 20, 2009, and in light of the telephonic interview with the Examiner (discussed below).

Telephonic Interview

Applicants thank Examiner Fernandez for speaking with Applicants' representatives, Christine O'Day and Brian Landry, on January 12, 2010 (hereinafter "the Telephonic Interview").

35 U.S.C. § 112

Applicants thank Examiner Fernandez for her indication during the Telephonic Interview that the previous amendment to claim 49 resolves the outstanding rejection under 35 U.S.C. §112.

Applicants currently amend claim 51 to replace instances of "container" with "cell culture dish" to reflect the previous amendment to claim 49 as helpfully suggested by the Examiner during the Telephonic Interview.

¹ Applicants note that claim 49 was amended in the Amendment in Response to Non-Final Office Action filed on October 20, 2009.

35 U.S.C. § 103

Claims 31-40, 42-47, 49 and 51-61 are rejected under 35 USC §103(a) over U.S. Patent No. 5,998,129 to Schutze et al. (hereinafter “Schutze”) in view of U.S. Patent No. 6,251,467 to Liotta et al. (hereinafter “Liotta”).

As discussed during the Telephonic Interview, Applicants respectfully assert that claims 31-40, 42-47, 49 and 51-61 are patentable over Schutze and Liotta because neither reference teaches or suggests an adhesive agent that is dissolvable without impairing the suitability of the specimen for predetermined processing and/or analysis as recited in currently amended independent claims 31, 36, 37, 38, and 56.

Schutze does not teach or suggest an adhesive that is dissolvable without impairing the suitability of the specimen for predetermined processing and/or analysis as reflected at page 4 of the Office Action.

During the Telephonic Interview, it was acknowledged that agarose, though mentioned in Liotta, was not the “activatable adhesive layer” described in Liotta. (This point was made in the response filed on October 20, 2009; see the response at page 9.)

Beyond that, the undersigned Attorneys discussed with the Examiner the differences between the adhesive agent of the present invention and the activatable adhesive layer of Liotta. Particular attention was drawn to the feature of the present invention whereby the adhesive agent can be dissolved without impairing the suitability of the specimen for further processing and/or analysis. The undersigned Attorneys submitted that though Liotta’s adhesive layer was “activatable”, that was not necessarily equivalent to being dissolvable, much less dissolvable and without causing such impairment. As part of our discussion, Examiner Fernandez pointed to Liotta at column 9, beginning on line 55, where examples of suitable adhesive materials are described. The Examiner suggested that the position could be taken that the “activatable adhesive layer” disclosed in Liotta could still be a dissolvable adhesive depending upon which of those materials were chosen.

As a preliminary matter, Applicants respectfully assert that the mere possibility that a disclosed element could potentially constitute a claimed feature, without a further

teaching that the element actually does constitute the claimed feature, is insufficient to establish a *prima facie* case of obviousness.

Nonetheless, even if the adhesive layer taught by Liotta is dissolvable, Liotta does not teach or suggest that such an adhesive layer is dissolvable “without impairing the suitability of the specimen for predetermined processing and/or analysis” as recited in the currently amended independent claims.

For example, Liotta discusses that adhesive/extraction reagent 6 can be “a mixture of piccolyte and xylene.” As demonstrated in the attached printout from the USPTO TESS database, the PICCOLYTE® trademark is used in connection with “hydrocarbon resins.” Xylene is a mixture of three aromatic hydrocarbon isomers (o-xylene, m-xylene, and p-xylene). While such a mixture of polar compounds could potentially be dissolvable, one of ordinary skill in the art would readily appreciate that the strong solvents (e.g., xylene) required to dissolve such an adhesive would render the specimen unsuitable for further processing and/or analysis. The same holds true for the other adhesives disclosed by Liotta. Indeed, Liotta teaches the immersion of the sample, which is still adhered to adhesive/extraction reagent 6, into a reagent solution 8 “which removes all or a desired component of the extracted sample zone from the contact probe tip” and “dissolves the tissue material for analysis purposes.” Liotta, col. 6, lines 33-46.

Thus, even if one of ordinary skill in the art were to consider both Schutze and Liotta, the combination would still not teach or suggest an adhesive agent that is dissolvable without impairing the suitability of the specimen for predetermined processing and/or analysis as currently recited by Applicants.

Accordingly, Applicants respectfully request the withdrawal of the rejection of claims 31-40, 42-47, 49 and 51-61 under 35 U.S.C. § 103(a) over Schutze in view of Liotta.

Claims 31-61 are rejected under 35 USC §103(a) over Schutze and Liotta in further view of U.S. Patent No. 4,902,295 to Walthall et al. (hereinafter “Walthall”), U.S.

Patent No. 4,870,005 to Akiyoshi et al. (hereinafter "Akiyoshi"), U.S. Patent No. 6,284,503 to Caldwell et al. (hereinafter "Caldwell"), and U.S. Patent No. 6,027,695 to Oldenburg et al. (hereinafter "Oldenburg").

As discussed previously, Walthall, Akiyoshi, Caldwell and Oldenburg cannot remedy the deficiencies of Schutze and Liotta. Walthall is cited for its disclosure that agarose polymers can be dissolved by treatment with an agarase solution. Akiyoshi is cited for teaching an adhesive layer that can be comprised of agarose or polyacrylamide. Caldwell is added for teaching that collagen can adhere to many cell types. Oldenburg is cited for teaching that microtiter plates can be formed from a highly reflective material such as acrylic so as to enhance the performance of the plate when used for measuring luminescence.

Even *if* such teachings are provided by these various references, the defects and lack of motivation to combine Schutze and Liotta are paramount. The cited references, even in the stated combinations, are insufficient to sustain the rejections under §103(a). In view of the foregoing, reconsideration and withdrawal of the rejections under 35 USC §103(a) are respectfully requested.

Conclusion

In view of the above amendments and remarks, Applicant believes the pending application is in condition for allowance.

If a telephone conference would be useful in expediting prosecution of the application, Applicant invites the Examiner to call the undersigned Attorney at the telephone number indicated below.

Fee Authorization

Applicants believe that no fees are required for submission of this paper. The Commissioner is authorized to charge any fees required in connection with this submission to our Deposit Account, No. 04-1105, Reference 65752(45107). Any overpayments should be credited to said Deposit Account.

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